

### Remarks

Claims 1-14 are pending. Claims 1-2, 4-9 have been amended, applicants have cancelled non-elected subject matter. Claim 14 is new and finds support in claim 5 as originally presented and page 16 of the specification. No new matter has been introduced into this application by way of amendment. In the paper dated 12/7/2005, applicants had requested rejoinder of method and process claims 10-12 of equal scope to compound claims upon a determination of allowable compound claims.

### Claim Rejections

Claims 1-9 and 13 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1 and 14 of Cogan et al. co-pending application no. 11/002,022 (US 2005/0153972 A1).

In the Office Action it is asserted that the difference between the presently claimed compounds and Cogan et al. '022, is that the instant variable Ar1 represents carbocycle, while Cogan et al. '022 represents phenyl at the same position. Applicants disagree that phenyl is the only difference, it is the substitution on the phenyl which provides structural distinctness. Nevertheless, to advance prosecution in the case, applicants have amended the present claims to limit Ar1 such that Ar1 must be substituted with one R1 and R1 is NO<sub>2</sub>, -N(R<sup>c</sup>)<sub>2</sub>, J-C(O)- N(R<sup>c</sup>)- or J-S(O)<sub>m</sub>- N(R<sup>c</sup>)-, the hydrogen has been deleted. Applicants have also submitted a preliminary amendment in co-pending application no. 11/002,022 to eliminate the overlap by deleting in claim 1 of that application, the optionally substituted amino from the R2' definition. R2' is attached to ring (ii).

It is believed the present amendment and the preliminary amendment in co-pending application no. 11/002,022 overcomes the provisional obviousness type double patenting rejection.

Claims 1-9 and 13 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1 and 11 of Cogan et al. co-pending application no. 11/120,735 (US 2005/0256113 A1).

In the Office Action it is asserted that the presently claimed compounds are structural isomers, i.e., the Examiner specifically points out the reference US 2005/0256113 disclosing the triazol-2-yl:



, comparing this molecule to the instantly claimed compounds possessing 1H-triazolyl:



It is then alleged that one of ordinary skill in the art would have been motivated to prepare the instantly claimed compounds because it is alleged that such isomeric compounds are suggestive of one another and there would therefore be an expectation that they share similar properties, citing *In re Norris*.

Applicants contend that the Cogan '113 reference does not provide synthesis for the structurally similar compounds, as such no prima case of obviousness has been made out. The instant claims triazol-1-yl compounds whereas Cogan '113 discloses triazol-2-yl and triazol-4-yl. The syntheses are also distinct for each of the different compounds. In Cogan '113, the di-nitrogen 5-membered rings are exemplified. The instant compounds in contrast, triazol-1-yl intermediates are made by the novel general methods in schemes I-III as shown on pages 47-50 of the specification.

It has been held that if prior art of record fails to disclose or render obvious a method for making a claimed compound, at the time the invention was made, it may not be legally concluded that the compound itself is in the possession of the public. *In re Hoeksema*,

158 USPQ 596 at 601 (CCPA 1968). In *In re Hoeksema*, despite the fact that the prior art reference (De Boer which was used to make a 35 USC 103 rejection) disclosed structurally similar compounds, the patent had not made any showing that the claimed compound could have existed. This was because the prior art of record has not shown any way to manufacture it, therefore the court concluded that “the invention as a whole, which 35 USC 103 demands that we consider, is not obvious from the prior art of record.”

Moreover, the case law the Examiner relies on does not supports the Examiner’s position that in the present case, ‘the disclosure of one structural isomer in a heteroaromatic compound is sufficient by itself to establish a *prima facie* case of obviousness of the other structural isomer’. In *In re Norris*, the isomers involved were structural isomers which could be produced in a similar manner. *Id at 461*. The examiner in holding the claim to be unpatentable, stated that the general class of compounds made by the same general process were disclosed in the prior art. *Id at 459*. The court in describing precedent (*In re Finley*), stated that no distinction for analyzing patentability is to be made for homologs and isomers (structural), “both types of compositions being produced in substantially the same manner.” *Id at 460*.

Here, the Office has not proffered evidence that Cogan ‘113, alone nor in combination with any other reference, shows any way to manufacture the claimed compounds. As such a *prima facie* case of obviousness has not been established.

In view of the foregoing, withdrawal of the above rejections is proper and respectfully requested.

Respectfully submitted,

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